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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/679,747 | 10/05/2000 | Yuji Natori | 2271/63282 | 9093 |

7590 09/27/2002

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EXAMINER

YAN, REN LUO

ART UNIT PAPER NUMBER

2854

DATE MAILED: 09/27/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

| | | |
|--|-----------------------|------------------|
| | Application N . | Applicant(s) |
| | 09/679,747 | NATORI ET AL. |
| | Examiner Ren L Yan | Art Unit 2854 |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 15 July 2002.
 2b) This action is non-final.
 2a) This action is FINAL.
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-17 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
 5) Claim(s) _____ is/are allowed.
 6) Claim(s) 1-17 is/are rejected.
 7) Claim(s) _____ is/are objected to.
 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.
 If approved, corrected drawings are required in reply to this Office action.
 12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
 * See the attached detailed Office action for a list of the certified copies not received.
 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
 a) The translation of the foreign language provisional application has been received.
 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
 3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.

- 4) Interview Summary (PTO-413) Paper No(s) _____.
 5) Notice of Informal Patent Application (PTO-152)
 6) Other: _____

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DETAILED ACTION

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 1-6, 8-14, 16 and 17 are rejected under 35 U.S.C. 102(e) as being anticipated by Tanaka et al(6,050,183). The patent to Tanaka et al teaches the stencil and method of making such a stencil as claimed including a stencil shown in Fig. 4 having a porous resin layer 10, a thermoplastic resin layer 20, a non-resinous porous layer 40 formed on the porous resin layer 10, and an adhesive resin layer interposed between the porous resin layer and the thermoplastic resin layer for bonding the two layers together. See the entire Tanaka et al patent for details. Tanaka et al also teach the range of air permeability and the perforation open ratio of the stencil as recited in claim 10. With respect to claim 13, the method steps of forming a stencil are also clearly taught by the teaching of Tanaka et al.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 7 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tanaka et al in view of Ohta et al(5,843,560). Tanaka et al teach the method of making a stencil as claimed except for the porous resin layer being formed through a coating composition. With respect to claim 15, Ohta et al teach in a method of making a stencil the conventionality of applying on a thermoplastic resin layer a coating liquid containing a mixture of good solvent and a poor solvent and then drying it to form a porous resin layer. See the abstract of Ohta et al for example. In view of the teaching of Ohta et al, it would have been obvious to those having ordinary skill in the art to provide the stencil making method of Tanaka et al with the alternative of forming the porous resin layer through a coating liquid. The mere application of known way of forming a porous resin layer on a thermoplastic resin layer to produce a stencil by those having ordinary skill in the art based upon its well known properties and intended use in order to achieve an expected outcome would have been most obvious. With respect to claim 7, Ohta et al clearly teach that the stencil is preferred to have a flexural rigidity of 10-50mN for reasons of proper transferability of the printing stencil in a printer. It would have been obvious to one of ordinary skill in the art to provide the stencil of Tanaka et al with the proper flexural rigidity for the same reason in order to ensure printing quality.

Applicant's arguments filed on 7-15-2002 have been fully considered but they are not persuasive. The argument presented by the applicant that the Tanaka patent teaches to use an adhesive resin layer only when the porous support 10 is a thin paper is only selfserving.

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Apparently, applicant has conveniently overlooked the most pertinent teaching of Tanaka et al, in column 7, lines 43-45 where it clearly stated that "if desired, an adhesive layer may be interposed between the porous resin layer and the thermoplastic resin film". This adhesive layer was defined earlier in the patent as a solvent solution of a resin such as an acrylic resin....

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ren L Yan whose telephone number is 703-308-0978. The examiner can normally be reached on 8:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Hirshfeld can be reached on 703-305-6619. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-7722 for regular communications and 703-308-5841 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding
should be directed to the receptionist whose telephone number is 703-308-0956.



Ren L Yan
Primary Examiner
Art Unit 2854

Ren Yan
September 25, 2002